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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,365	09/27/2001	Kazuo Kondo	0425-0854P	9474

2292 7590 09/15/2003

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EXAMINER

WEBMAN, EDWARD J

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 09/15/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/963765

Applicant(s)

KONDO

Examiner

WERNER

Group Art Unit

167

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 8/5/03
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1, 2, 20-24 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 1, 2 is/are allowed.
- ☒ Claim(s) 20-24 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Claims 20, 21, 23 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for arteriosclerosis and heart disease, does not reasonably provide enablement for diseases other than arteriosclerosis and heart disease. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. On page 9, line 3 of the specification, Applicants only discloses arteriosclerosis and heart disease. No other diseases are specified.

Applicants argue that no reasoning has been provided for lack of enablement. Applicants provide no evidence for efficacy in treating Ischemia in Blood vessels in the Brain. Applicants provide neither direction (a wand factor) nor an example (a wand factor) regarding treatment of Ischemic conditions in the Brain. Further, in its broadest interpretation, a disease caused by oxidation in vivo, including oxidation of low density lipoprotein, includes starvation. Nowhere in the specification do applicants contemplate such a disease. Applicants argue no undue amount of experimentation. However, the issue ultimately is the scope of diseases contemplated by applicants in comparison to the scope of the claims.

Claims 20-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 20,23 the term "preventing" is vague. It is unclear as to what criteria are used to determine "prevention". It's a subjective term.

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Applicants argue that the invention satisfies the statute. However, no criteria ^{-for} determining ~~for~~ "prevention" are disclosed.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 20-24 are rejected under 35 U.S.C. 101 because applicants provide no evidence of prevention. Further, such evidence cannot be demonstrated simply because symptoms can arise at any time beyond any experimental period of observation designated by applicants.

Applicants refer to their argument in paper # 11, filed 10/21/02. In that argument, applicants cite evidence that the claimed compounds block an oxidation starter as evidence for prevention. However, applicants only show blockage for a finite period of ^{time} ~~none at~~ rather than permanent blockage.

Claim 23 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. No where in the specification is "peroxidated" disclosed.

The disclosure is objected to because of the following informalities: on page 5 the penultimate line, 'etc' is vague; it is non limiting, "and the like" is suggested.

Appropriate correction is required.

Claims 1-2 allowed.

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Claims 20-24 rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward J. Webman whose telephone number is 308-4432. The examiner can normally be reached on Monday-Friday 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Padmanabhan can be reached on 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1234.

Webman/tgd
August 27, 2003

A handwritten signature, possibly 'J. Webman', is written over a rectangular stamp. The stamp contains some text that is mostly illegible due to the signature and the quality of the scan, but it appears to be an official mark or date stamp.